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09/927,543	08/13/2001	Josephine L. Ferguson		6085

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 04/24/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,543

Applicant(s)

FERGUSON, JOSEPHINE L.

Examiner

Jenna-Leigh Befumo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment A, submitted as Paper No. 3 on September 19, 2001, has been entered.

Claims 1 – 2 have been cancelled. Claims 3 – 13 have been added. Therefore, the pending claims are 3 – 13.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3 – 7, 9, and 12 – 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using nylon as the non-absorbent material in the protective, does not reasonably provide enablement for using generic non-absorbent fibers in the protective cover. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification only teaches that nylon is used to make the protective cover and does not disclose the any other non-absorbent fibers can be used instead of nylon. Further, the specification fails to teach or suggest that non-absorbent fibers other than nylon would produce the same protective properties as nylon. Thus, the disclosure explicitly teaches that nylon is used in the cover to produce the protective properties and does not provide any suggestions to one of ordinary skill in the art that other materials besides nylon can be used in the protective cover. The claims should be amended to be the same scope as the specification, since the Applicant is only entitled to claim that which is disclosed in the specification.

Art Unit: 1771

4. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The specification does not teach that contrasting portion is made of material other than nylon. Thus, the limitation in claim 11 is considered new matter since it was not present in the application as originally filed. While the specification does disclose a contrasting portion is used, there is no teaching stating that the material is made from a different fabric. It could be contrasting for any number of reasons such as color, texture, or structure. Therefore, the limitation in claim 11 that the contrasting portion is made from a material other than Nylon is considered new matter since and should be removed from the claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3 – 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 3 is indefinite because it is unclear if the non-absorbent material is a third component in addition to the front portion and the back portion. Or, is the non-absorbent material what the front and back portions are made from? Based on the disclosure, it is presumed that the front and back portions are made from the non-absorbent material, The Applicant must amend the claim so that it is clear how the non-absorbent material relates to the front and back portion. If it is a third component where is it positioned in relation to the front and back portion. And, if it is what the front and back portion is made from than the claim

Art Unit: 1771

should be amended so that it states the front and back portions are made from the non-absorbent material. Claims 4 – 13 are rejected due to their dependence on claim 3.

8. The term "low frictional surface" in claim 5 is a relative term which renders the claim indefinite. The term "low frictional surface" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how low the frictional surface of the fabric must be to qualify as a "low" frictional surface. The Applicant must define the term so that it would be clear to one of ordinary skill in the art what would qualify as a "low" frictional surface. The Applicant can do this by including claim language which describes how the "low" frictional surface will function, such as a low frictional surface which eliminates friction between the protective cover and another material. Since the fabric is intended as the pillow case the Applicant could do this by stating "a protective cover for hair" and then stating in the dependent claim that the cover eliminates friction between the protective cover and hair.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 3 – 9 and 12 rejected under 35 U.S.C. 102(b) as being anticipated by Skillington (5,084,928).

Art Unit: 1771

Skillington discloses a wrinkle free pillow case (abstract). The pillow case is made from a nylon and spandex blend (column 2, lines 26 – 27). Skillington discloses that the prior art teaches using a smooth material such as satin to protect hairdos without caps, nets, clips, or wraps overnight (column 2, lines 5 – 11). The pillow case material is preferably at least 85% nylon (column 4, lines 1 – 2). Further, Skillington teaches that the material is stretched taut against the surface of the pillow which prevents marks from being left on the user's skin (column 2, lines 26 – 28). The pillow case can be made in different sizes to fit standard, queen and king size pillows, with the fabric panels being made to specific lengths and widths depending on the pillow size (column 3, lines 9 – 16).

Since Skillington teaches using the same material as that taught by the Applicant, i.e., nylon, then the pillow case taught by Skillington will inherently have the same absorbency and barrier properties claimed by the Applicant. Therefore, claims 3 and 6 – 9 are anticipated by Skillington. Since Skillington teaches the length and width of the fabric panel, the upper and lower panel in the pillow case will be the same size. Thus, claim 12 is also anticipated.

Further, since Skillington teaches that the fabric is stretched taught, made from at least 85% nylon, and is wrinkle-free, then the fabric will inherently have a smooth texture and a low frictional surface. Therefore, claims 4 and 5 are anticipated.

11. Claims 3 – 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Elesh (4,525,409).

Elesh is drawn to a woven pillow case made from nylon or polyester (abstract). The fabric is made from nylon threads with a fineness of 70 – 100 denier to provide a softer fabric (column 1, lines 65 – 68). And the fabric has a thread density of 88 threads in one direction and

Art Unit: 1771

104 threads in the other direction (column 2, lines 1 – 3). Therefore, the fabric would inherently produce a smooth woven fabric with a low frictional surface. Elesh teaches that fabric can be used to cover a pillow (column 1, lines 14 – 15). A pillow case would inherently have a front portion and a back portion.

Since Elesh teaches using the same material as that taught by the Applicant, i.e., nylon, then the pillow case taught by Elesh will inherently have the same absorbency and barrier properties claimed by the Applicant. Therefore, claims 3 – 9 are anticipated by Elesh.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elesh in view of Van Pelt (3,974,531) and Davis (6,427,268).

The features of Elesh have been set forth above. Elesh discloses that the nylon fabric can be used in pillow coverings is cut and sewn into the desired shape to produce the final product (column 1, lines 62 – 64). However, Elesh fails to teach the specific shape of the pillow case.

Van Pelt discloses a pillow case made from a front center and rear panel (abstract). Figure 2 shows that the panels can be all the same size. However, as shown in Figure 6, the panels are not necessarily the same size since panel 14 does not completely overlap panel 18. Van Pelt teaches that the panels can be made from two different types of fabric (column 4, lines 13 – 20).

Art Unit: 1771

Davis is also drawn to a pillow cover. Davis discloses a multi-panel pillow sham which is made from three sections or panels, **14**, **16**, and **18** (abstract). As shown in Figure 7, the panels are different sizes. Further, Davis discloses that the different fabric combinations can be incorporated into the product (column 6, lines 3 – 5).

Therefore, it would have been obvious to one of ordinary skill in the art to make pillow cases in various constructions, such as those taught by Van Pelt and Davis, from the fabric of Elesh, since Elesh teaches the fabric can be used to make pillow cases and that the fabric can be cut and sewn into any desired shape. Further, it would have been obvious to one of ordinary skill in the art to choose a known pillow case pattern when making the final product since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Finally, it would have been obvious to one of ordinary skill in the art to choose contrasting fabrics as taught by Van Pelt and Davis in the pillow case produced by Elesh to vary the aesthetic appearance of the pillow and to broaden the ranges of colors and designs used in the pillow case, as well as vary the texture and feel of the pillow case so that it is more attractive to consumers. Therefore, claims 10 – 13 are rejected.

14. Claims 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillington in view of Van Pelt and Davis.

The features of Skillington have been set forth above. Skillington fails to teach using panels of different sizes of having contrasting panels in the pillow case. The features of Van Pelt and Davis have been set forth above.

Therefore, it would have been obvious to one of ordinary skill in the art to make pillow cases in various constructions, such as those taught by Van Pelt and Davis, using the stretchy material taught by Skillington, to produce different shape pillow cases for different sized pillows, which are wrinkle free thereby prevent marks from being left on a users skin. Further, it would have been obvious to one of ordinary skill in the art to choose a known pillow case construction when making the pillow case since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a set forth above.

Finally, it would have been obvious to one of ordinary skill in the art to choose contrasting fabrics as taught by Van Pelt and Davis in the pillow case produced by Skillington to vary the aesthetic appearance of the pillow and to broaden the ranges of colors and designs used in the pillow case, as well as vary the texture and feel of the pillow case, while still maintaining a smooth wrinkle free surface to lay on, so that it is more attractive to consumers. Therefore, claims 10, 11, and 13 are rejected.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Additional references which teach various pillow case designs which have multiple panels include Lewis (5,430,902), Kraemer (5,652,983). Castro (5,829,079), and Sorbo et al. (6,473,924 B1). And Bland (5,099,533) discloses that smooth, satin pillow cases preserve the style, body, and shape of hair while a person is sleeping so that hair covering do not need to be used.

Art Unit: 1771

16. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
April 17, 2003



CHERYL A. JUSKA
PRIMARY EXAMINER